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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/037,380	10/23/2001	William Brum	B01-50	4120

7590 11/10/2003  
D. Michael Burns  
Acushnet Company  
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EXAMINER

CROWELL, ANNA M

ART UNIT PAPER NUMBER

1763

DATE MAILED: 11/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary****Application No.**

10/037,380

**Applicant(s)**

BRUM, WILLIAM

**Examiner**

Michelle Crowell

**Art Unit**

1763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17 is/are pending in the application.
- 4a) Of the above claim(s) 9-16 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-17 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 October 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 10-23-01. 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-8 and 17, drawn to an apparatus, classified in class 118, subclass 723e.
  - II. Claims 9-16, drawn to a method, classified in class 427, subclass 536.
2. Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the apparatus as claimed can be used to practice another and materially different process, such as processing other spherical substrates.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.
4. During a telephone conversation with Mr. Michael Burns on October 24, 2003 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-8 and 17. Affirmation of this election must be made by applicant in replying to this Office action.

Claims 9-16 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Drawings***

5. Figures 1-3 and 7 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g). A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claim 8 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

8. Claim 8 recites the limitation "the basket" in line 1. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 102***

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1, 2, and 7 are rejected under 35 U.S.C. 102(b) as being anticipated by Oyachi et al.

Referring to Figures 1, 1B, 2, and column 3, lines 44-63, Oyachi et al. discloses an apparatus for treating a golf ball surface comprising a sealed casing 1, a tumbler 5 for holding golf balls 6 in the casing, and an electric source 7 for applying high voltage across the electrodes 1, 8 in order to generate glow discharge (col. 3, lines 44-53), wherein the improvement comprises the tumbler further having a plurality of perforated holes in a staggered pattern covering a substantial portion of the tumbler surface (col. 3, lines 57-58, Fig. 1B).

With respect to claim 2, the apparatus includes a plurality of holes which are individually machined. Although the Oyachi et al. is silent on how the holes are made, this feature is not patentably distinct since a recitation of "how the holes are made" in the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. Therefore, since the prior art structure of Oyachi et al. having a tumbler with perforated holes is capable of performing the intended use of treating golf balls, then it meets the claim.

With respect to claim 7, the apparatus further includes a pattern that yields an open hole surface area of greater than 50 percent (see Fig. 1B).

#### *Claim Rejections - 35 USC § 103*

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oyachi et al. in view of Usui et al. (U.S. 5,591,268).

The teachings of Oyachi et al. have been discussed above.

Oyachi et al. fails to teach holes having a curved radius machined about their outer edges. Referring to Figure 6b and column 9, lines 36-44, Usui et al. teaching an apparatus having a cylindrical electrode member 22a having a curved radius machined about their outer edges. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the holes of the tumbler of Oyachi et al. with a curved radius machined about their outer edges as taught by Usui et al. since the cylindrical electrode member of Usui et al. is an equivalent structure to the tumbler electrode in Figure 2 of Oyachi et al.

13. Claims 4-6 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Oyachi et al. in view of Usui et al. (U.S. 5,591,268).

With respect to the dimensions of the holes (claims 4-6, 17), where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

14. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Oyachi et al. in view of Kaji et al. (U.S. 5,895,586).

The teachings of Oyachi et al. are discussed above.

Oyachi et al. fails to teach an aluminum sheet metal approximately 0.25 inches to 0.375 inches thick, and the sheet metal having a hard anodic coating applied thereon.

Referring to the abstract and column 5, line 44-column 6, line 5, Kaji et al. teaches a glow discharge apparatus wherein the components are made of aluminum having a hard anodic coating. Aluminum is a known material used in glow discharge apparatus and anodic coatings are known protective coatings. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to make the tumbler of Oyachi et al. of aluminum with a hard anodic coating as taught by Kaji et al. since aluminum is a known material used in glow discharge apparatus and anodic coatings are known protective coatings. Additionally with respect to the thickness of the aluminum sheet, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. In *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338, 220 USPQ 777 (Fed. Cir. 1984), cert. denied, 469 U.S. 830, 225 USPQ 232 (1984).

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*Conclusion*

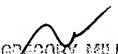
15. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Gerrity et al. '916, Yoshikawa et al. '532, Steube '147 show an apparatus used to produce golf balls and apparatus using tumblers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michelle Crowell whose telephone number is (703) 305-1956. The examiner can normally be reached on M-F (8:00 - 4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gregory Mills can be reached on (703) 308-1633. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

AMC *gmc*

  
GREGORY MILLS  
SUPERVISORY PATENT EXAMINER  
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